

Comments

Status of Claims

The claims presently under consideration are claims 3-11 and 13.

Claims 1 and 2 are withdrawn from consideration as being directed to a non-elected invention.

Claim 12 is canceled.

Rejection 35 U.S.C. § 102.

The rejection of claim 12 over *Nelson* under 35 USC § 102 is made moot by the cancellation of claim 12.

Rejection 35 U.S.C. § 103

Claims 3-13 (now 3-11 and 13) stand rejected as being unpatentable over *Nelson* in view of *Crouch et al* and further in view *Ellis* and *Stayner*. *Nelson* teaches a fire suppressing composition containing Attapulgitic clay and water. *Crouch et al* also teaches a fire retardant composition containing Attapulgitic clay and water. Neither *Nelson* or *Crouch et al* teach magnesium sulfate (Epson salt) to be present in their Attapulgitic and water containing composition. The deficiency of *Nelson* and *Crouch et al* is said to be made up by *Ellis* and *Stayner* who show magnesium sulfate as an ingredient in fire retardant compositions. While *Ellis* and *Stayner* do show magnesium sulfate in a fire-retardant composition, there is no suggestion in the references to use magnesium sulfate

along with Attapulgite clay and water to form a sprayable suspension to be readily sprayed as a suspension and to set up as a film-barrier on the surface to be protected. Clearly there is no suggestion in the prior art applied to select out and add the magnesium sulfate from among the many ingredients set forth in the *Ellis* and *Stayner* references to the Attapulgite and water of *Nelson* or *Crouch et al.*. Further, patent law requires that there be a suggestion or motivation to combine the references, in *re Fine* 5 USPQ.2d 1596 and see also *Winner v. Wang* 48 USPQ.2d 1139. No clear motivation is found in the references applied by the Examiner.

In making her rejection over the above references, the Examiner invites a showing of unexpected results attributable to the inorganic salt employed. Applicants advise that there is no requirement to make a showing of unobviousness under the Supreme Court decision *Graham v. John Deere* 148 USPQ 459. However, to convince the Examiner of patentability, the following paragraphs are referred to show unusual effects for applicants' composition.

The Examiner is requested to note that claims 5 and 8 have been amended to specify a particular type of Attapulgite clay. This specific type of clay is patented in U.S. Patent No. 6,444,601 and U.S. Patent No. 6,130,179, and has been given a tradename "Acti-Quench™. This specific clay has properties which make it particularly effective

for use as a film forming agent in fire protective coatings to be used on surfaces to protect against the advance of fire.

The Examiner is also requested to note (see specification pages 9 and 10) that Acti-Quench has particular beneficial properties as for example:

1. Absorbs 200% of its weight in water.
2. Has special rheologic properties which allow it to be pump-sprayed onto all contact angles.
3. Evaporative cooling allowing for two-stage evaporative release of water.

These advantages are not shown or suggested by the prior art cited.

Further, the Examiner's attention is directed to the tests set forth in the tables on pages 13-17 of the specification which show that Acti-Quench™ (a clay based fire retardant) performed satisfactorily as compared with Barricade™ (a polymer based fire retardant) and Nochar Fire Preventer™ (a water-soluble fire retardant). In fact in test Table 2 Acti-Quench™ was superior to the commercial products and in other specific categories Acti-Quench™ out performed the commercial product.

Claims 3-11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Speronello et al*, in view of *Hallo et al* and *Drew et al*,. The Examiner has repeated her rejection of August 10, 2005 and offered a rebuttal to applicants' response of October 27, 2005.

The Examiner is correct in stating that *Aperonello et al* teaches a composition containing Attapulgitic clay, magnesium sulfate and water and that claim 12, regardless of intended use in the preamble, would lack novelty over *Aperonello et al*; and accordingly, would because of this lack of novelty be unpatentable under 35 U.S.C. § 102. For this reason claim 12 has been canceled. However, the rejection under 35 U.S.C. § 103 over *Speronello et al* in view of *Hallo et al* and *Drew et al* present a different issue as to patentability.

A rejection under 35 U.S.C. § 103 is governed by the Supreme Court decision *Graham v. John Deere* 148 USPQ 459 and decisions thereunder. In accordance with *Graham v. John Deere*, the Examiner must set forth the differences in the claim over the applied references. The second step requires that the Examiner set forth the proposed modification of the reference which would be necessary to arrive at the claimed subject matter. And, the third step requires that the Examiner explain why the proposed modification would be obvious.

In explaining obviousness, there must be some suggestion or motivation in the references for combining the references of the prior art. (In re Fine 5 USPQ2d 159.) The fact that prior art could be modified to reflect features of the claimed invention does not make that modification obvious unless the desirability of such a modification is suggested by prior art. (In re *Gorden* 221 USPQ at 1127.) Clearly, the prior art cited by the

Examiner lacks such a suggestion or motivation to make the instantly claimed combination. The rejection should be withdrawn.

Summary

Applicants have pointed out wherein non-analogous art has been improperly combined.

No prior art reference or combination thereof shows applicants' method of using the claimed composition for fighting fires.

Applicants' composition as herein pointed out above has unobvious properties which are persuasive of unobviousness.

Applicants further point out that their preferred product is not a ground Attapulgitic clay, but an Attapulgitic which is highly purified made by a wet chemical process and has particles which are extremely small. Further, the Epsom salt in our product is not used as a fire-retardant *per se*, but is used to activate the charges on the micro-processed Attapulgitic, and thereby making a stronger gelling product. Further note, applicants claimed composition is to be used as a barrier to prevent the advance of a fire.

It appears that all matters have been satisfactorily addressed, and the Examiner is requested to indicate allowable subject matter in this application.

Serial No.: 10/696,197
Docket No.: 03283-PA
Inventors: Parker et al

Sincerely,

April 4, 2006
Date

Sam Rosen
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Date: April 4, 2006

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